

REMARKS

Claims 15 and 34 have been amended. Claims 1-20 and 32-35 therefore are pending and are presented for review. Favorable reconsideration and allowance are requested in light of the foregoing amendments and the remarks that follow.

1. Interview Summary

Applicant and applicant's representative wish to thank Examiner Hylton for her courtesy during the personal interview conducted May 23, 2006. During this interview, applicant's representative and the inventor, Corbett Hefner, met with Ms. Hylton. Mr. Hefner demonstrated prior art bags and bags constructed in conformance with the claimed invention. He also explained that the claimed reinforcing strip produces significant improvement in strength and dramatic reduction in failures as discussed on page 19, line 19 through page 20, line 1 of the present application. Mr. Newholm argued that the Examiner's purported motivation to modify the bags of the cited Huertas patent to produce the claimed invention is nothing more than impermissible hindsight reconsideration and that the real world improvements of the claimed differences, as evidenced by the data reproduced in the specification, compels withdrawal of the rejection. Ms. Hylton indicated that she would consider applicant's arguments and supporting documentation upon the submission of a formal response and reach a conclusion at that time.

2. Objection of the Title

The specification stands objected to because the title purportedly was not descriptive. The title has been amended to be more descriptive, thereby obviating this objection.

3. Rejection Under 35 U.S.C. §112, ¶2

Claims 15 and 34 stand rejected under 35 U.S.C. §112, ¶2, as being indefinite. Claims 15 and 24 have been amended to obviate this rejection. Withdrawal therefore is believed to be in order and is respectfully requested.

4. Rejections Based on Prior Art

All claims stand rejected as being obvious over the prior art including Huerta alone or in combination with Fox and/or Savigny. These rejections are respectfully traversed.

a. Recapitulation of the Invention<sup>1</sup>

The invention relates to a composite bag such as a so-called “half and half” bag having a first side wall formed at least in part from a synthetic resin mesh material and a second side formed from a synthetic resin film material. A reinforcing strip extends horizontally along the upper end portion of the mesh side wall of the bag. The reinforcing strip overlaps the upper edge of the first side wall such that it is joined to the first side wall through a horizontal seam positioned well beneath the top edge of the reinforcing strip to form an extension that protrudes well above (e.g., 1/2 inch to 1-1/2 inches or even considerably more, such as several inches or more) the upper edge of the mesh side wall. In order to strengthen the seam at the sides of the bag, the side edges of the reinforcing strip are joined to the second, film side wall along at least most of the vertical extent of the extension. This film-to-film bond is considerably stronger than

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<sup>1</sup> This Section 4a is intended to provide the Examiner with some background information on the state of the art and applicant's contribution to it. It is *not* intended to distinguish specific claims from the prior art. That task is performed in Sections 4b and 4c below.

a bond through an intermediate mesh layer, as occurs along the remainder of the side seams of the bag. In addition, the relatively long extension provides an improved contact point for suction cups or other equipment used on automated bag filling equipment to open a bag during a bag filling process. The improvements resulted in a strengthened area reflected by a dramatic reduction in bag failures during filling. Indeed, as discussed on pages 19 and 20 of the present application, extensive testing revealed that the inventive bags exhibited no failures, whereas prior art bags exhibited a failure rate of approximately 20 percent.

b. Rejections Based on Huertas Alone

Claims 1, 4, and 12, stand rejected under 35 U.S.C. §103(a) as being unpatentable over Huertas. The Examiner contends that Huertas discloses all that is recited in the rejected claims except for the presence as seen extending at least a majority of the vertical width of the extension like film-to-film bonding between the extension on the second film sidewall. The Examiner further contends that it would have been obvious to provide such seams in Huertas thereby weakening the seam edge and increase the storage space of the bag. This rejection is respectfully traversed.

Huertas discloses a multi-substrate bag having a film sidewall 1 and a whole mesh sidewall 2. The bags are formed on two continuous bands 1 and 2, respectively. A strip of plastic 3 is attached to the mesh band 2 so that the upper end of the side formed of the bands 2 and 3 have the same height as plastic bag 1. Holes 4 formed through both sheets 1 and 4 form handles for the bag. Importantly, and as recognized by the Examiner, the sheets 3 are not bonded

to the plastic 1 of the finished bags at all. They are bonded only to the mesh sidewall 2 as seen in Figure 4. This bonding provides an attachment point to the mesh sidewall and prevents the top of the mesh sidewall from unraveling.

Huertas contains no discussion or desirability of strengthening a side seam of the bag beyond that provided by the disclosed seams 7 nor does it provide any indication that Huertas or anyone else recognize that the bag would be strengthened by sealing the strip 3 to the plastic 1 at the edges of what would ultimately become the finished bags. While applicant acknowledges that motivation to modify or combine references may be implicit rather than explicit, such motivation must still be found in the prior art. As such, the purported motivation to combine Huertas constitutes nothing more than impermissible hindsight reconstruction of applicant's own bag. That is, the Examiner's conclusion that the claimed invention is obvious over Huertas is gleaned from applicant's own disclosure. A rejection such as this, that is based on hindsight reconstruction is untenable and should be withdrawn.

Furthermore, with respect to the declaration of the inventor, Corbett Hefner, that is attached as Appendix A, improvements resulting from bonding the ends of the reinforcing strip to the film sidewall are both dramatic and unexpected. Specifically, Mr. Hefner indicates that he would have expected to see a 10-15% reduction of bag failures when compared to the prior art bag referenced in the background section of the present application. Hence, in the test referred to on pages 19 and 20 of the present application in which a bag failure rate of about 20% was observed, Mr. Hefner would have expected to see a failure rate of about 16-18% in bags

constructed in accordance with the present invention. Instead, *no* failures occurred. In Mr. Hefner's opinion, this improvement was unexpected. A deprivation of unexpected results by a person skilled in the art is strong objective *indicia* of nonobviousness.

In addition, referring to the attached declaration of Scott Erickson, Vice President of Sales of Volm Bag Inc., of which the assignee of the present application is a wholly-owned subsidiary, at least \_\_\_\_\_ different companies have copied the invention since its introduction in \_\_\_\_\_. Copying by others is another strong objective *indicia* of nonobviousness.

Moreover, those skilled in the art would consider Huertas to teach directly away from the proposed modification. Specifically, referring to the attached declaration of Corbett Hefner, bags of the type disclosed in Huertas, which have handles, require the tops to be freely pulled apart to facilitate filling. Sealing the edges of the upper ends or film side of the bag to strips on the mesh side of the bag would provide for a smaller opening and inhibit filling – directly in contra-invention to standard procedure in the art. Moreover, as clearly seen in Figure 3, the bags of Huertas are produced in continuous sheets which require that they be pulled along a conveyor system by rollers or the like. Sealing the strip 3 to the film sheet 1 above the top of the mesh band would prevent engagement of the upper end of the bag with transfer rollers – again proceeding contrary to standard practice in the art.

Obviousness is always evaluated on the whole. Applicant submits that the Examiner has failed to establish of case of *prima facie* obviousness both because Huertas teaches away from the present invention and because the purported motivation to modify Huertas constitutes

improper hindsight reconstruction. In addition, any weak case of *prima facie* obviousness established by the Examiner's statements is more than overcome by the strong secondary *indicia* of non-obviousness including unexpected results and copying by others. As such, the rejection of independent claim 1 and claims 4 and 12 that depend from it should be withdrawn.

c. Rejection of Claims 2, 3, 5-11, 13, and 14 as being Unpatentable Over Huertas in View of Fox

The Examiner contends that it would have been obvious, in view of Fox, to modify Huertas 1) to use a synthetic resin fiber film mesh of cross laminated fabric for the mesh side of the bag of Huertas and, with respect to claims 8-10, to include wicket holes for purpose of facilitating filling. Applicant need not comment on the Examiner's statements regarding these claims because it is clear that Fox does not cure the basic deficiency of Huertas. It lacks any reinforcing strip on the mesh sidewall that extends well above the mesh sidewall and that is sealed to the film sidewall to provide the claimed film-to-film bag. The film sidewall 12, needs to be *below* the strip 32. See Figure 4.

Regarding claims 5-7, 11, 13, and 14, the Examiner states:

“Fox teaches the size of the strip is dependent upon the size of the bag and the size of the bag is dependent upon the intended use of the bag, i.e., the weight of the produce to be held in the bag.”

The Examiner is mistaken. In actuality, Fox states:

“The thickness and strength of the resin material on the strip 32 is selected according to the size of the bag as well as the weight of the produce to be packed in it.” (col. 3, lines 58-60)

Hence, one following the teachings of Fox might select the *thickness* of Huertas' strip and the material of the strip based on the size of the bag and the weight of the produce to be placed in it, but would not select dimensions of that strip according to the size of the bag and weight of the produce to be packed in it. The rejection of claims 5-7, 11, 13, and 14 is traversed for this additional reason.

d. Rejection of claims 15, 17-19, 34, and 35 as being unpatentable Over Huertas in View of Savigny

Claims 15, 17-20, and 32-35 stand rejected under 35 U.S.C. §103 as being unpatentable over Huertas in view of Savigny. Applicant need not comment on the details of the Examiner's rejection. Suffice it to say Savigny fails to disclose a composite bag having a film reinforcing strip on the top of the mesh side of the composite bag. It instead discloses an all film bag having first and second film sidewalls 79 and 80 as seen in Figure 12. Savigny cannot cure the base of deficiency of Huertas discussed in Section 4b above. Withdrawal of these rejections therefore is believed to be in order and is respectfully requested.

e. Rejection of claim 16 as being unpatentable Over Huertas in View of Savigny and further in view of Fox

Claim 16 depends from claim 15 and is believed to be patentably distinct over the art of record pursuant to the chain of dependency. The addition of Fox to the art of record is insufficient to overcome the shortfalls of the art as argued above.

f. Rejection of claim 20 as being unpatentable Over Huertas in View of Savigny

As argued above with respect to note d, contrary to the Examiner's conclusion, the art of record does not teach or suggest that which is called for in claim 20. Claim 20 calls for, in part, a reinforcing strip that is formed from a single, unfolded strip of material, and wherein said reinforcing strip protrudes well above the upper edge of the first sidewall. Claim 20 further defines that the reinforcing strip is directly joined to the second, film side wall without any other layers located therebetween. The Examiner states that "There is no disclosure of other materials between the wall seams or between the mesh wall and the reinforcing strip" and that "Thus, they are considered to be bonded directly to each other without other layers therebetween [and] plastic is known to be a synthetic resin." Regardless of the declarations enclosed herewith which contest this conclusion, simply alleging that because a reference does not disclose something additional -- it must be that which is claimed, is unreasonable. Such a conclusion bears the insidious signature of impermissible hindsight. Furthermore, upon consideration of the Declarations enclosed herewith, Applicant believes the patentability of the enclosed claims over the art of record is beyond question. Accordingly, Applicant believes claim 20 is in condition for allowance.

g. Rejection of claims 32 and 33 as being unpatentable Over Huertas in View of Savigny

Claims 32 and 33 depend from claims 1 and 9, respectively. As addressed above, the addition of Savigny to Huertas adds nothing to overcome the shortcomings of the art of record to

Proposed Response to Office Action dated December 30, 2005  
U.S. Serial No. 09/835,933 – Hefner  
Group Art Unit 3727 – Attorney Docket 81.010  
Page 17 of 18

teach or suggest each and every limitation as called for in the claims and as addressed above with respect to notes b, d, and f. In light of the documents and arguments presented herein, Applicant believes these claims are also in condition for allowance at least pursuant to the chain of dependency.

6. Conclusions

In light of the foregoing, withdrawal of all rejections and allowance of the application are believed to be in order and are respectfully requested. Should there be any remaining questions the attending to of which would expedite such action, the Examiner is requested to contact the undersigned at the telephone number appearing below.

The Director is authorized to charge Deposit Account No. 50-1170 the amount of \$510 in payment of the government filing fee by a *small* entity for a three-month extension of time, which Applicant hereby requests. No additional fee is believed to be payable with this communication. Nevertheless, should the Examiner consider any other fees to be payable in conjunction with this or any future communication, the Director is authorized to direct payment of such fees, or credit any overpayment to Deposit Account No. 50-1170.

Proposed Response to Office Action dated December 30, 2005  
U.S. Serial No. 09/835,933 – Hefner  
Group Art Unit 3727 – Attorney Docket 81.010  
Page 18 of 18

The Examiner is invited to contact the undersigned by telephone if it would help expedite  
matters.

Respectfully submitted,



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